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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,036	01/31/2000	Ruibing Hao	29250-000920/US	4280
7590	04/01/2005		EXAMINER PHILPOTT, JUSTIN M	
John E Curtin HARNES DICKY & PIERCE PLC P O Box 8910 Reston, VA 20195			ART UNIT	PAPER NUMBER
			2665	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/495,036

Applicant(s)

HAO ET AL.

Examiner

Justin M Philpott

Art Unit

2665

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

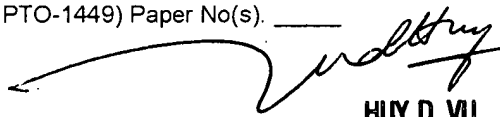
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: (continued, next page).

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

  
HUY D. VU  
SUPERVISORY PATENT EXAMINER  
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Applicant's arguments are not persuasive.

First, applicant argues that Fitzgerald does not include "evaluation of the inter-operability of communications systems" (page 5). In response to this argument, it is first noted that the only claim limitations reciting this or similar language are found in the preamble of claim 1. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus, in response to applicant's arguments, the recitation "evaluation of the inter-operability of communications systems" has not been given patentable weight because the recitation occurs in the preamble. Accordingly, this argument is moot. However, even if applicant's claims were amended to include this limitation within the body of the claim, Fitzgerald clearly teaches this broad limitation. That is, Fitzgerald teaches evaluating the interoperability of communications systems by evaluating the quality of service characteristics of various different network subsystems (e.g., see col. 2, lines 19-62). Thus, applicant's argument that Fitzgerald fails to teach such a limitation is not persuasive.

Second, applicant argues that Fitzgerald "requires the installation of loopback interfaces at one or more routers" (page 5), and applicant's claims do not recite such a limitation. In response to applicant's argument that Fitzgerald comprises an additional step, if true, applicant's claimed invention comprises broader limitations than the teachings of Fitzgerald and accordingly applicant's claimed invention cannot be patentable over Fitzgerald for this reason. That is, applicant cannot claim an invention more broadly than the cited art and persuasively argue that it should be patentable over the art which includes all of the limitations as well as potentially additional teachings. Accordingly, applicant's argument is not persuasive.

Third, applicant argues that "[t]he measurement of delay [in Fitzgerald] is not a desired mode of operation" (page 6, first paragraph). However, applicant has misrepresented Examiner's previous discussion of Fitzgerald in the Final Office action of December 29, 2004. Examiner has clearly equated a "desired mode of operation" as recited in applicant's claims to be that of "delay-free calling" in Fitzgerald (see Final Office action, December 29, 2004, page 2). It is not the "measurement" of delay that is a desired mode of operation, but rather, the function itself of operating in a "delay-free" mode that is the desired mode of operation. Clearly, Fitzgerald teaches the broad language of applicant's claim 1 reciting "implement[ing] the desired mode of operation" (e.g., see col. 2, lines 19-62).

Fourth, applicant argues that "Fitzgerald is simply not concerned, either explicitly or implicitly, with the operation or inter-operability of systems 14, 31" (page 6, first paragraph). In response to this argument, as discussed above, it is first noted that the only claim limitations reciting this or similar language are found in the preamble of claim 1. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus, in response to applicant's arguments, the recitation "evaluation of the inter-operability of communications systems" has not been given patentable weight because the recitation occurs in the preamble. Accordingly, this argument is moot. However, even if applicant's claims were amended to include this limitation within the body of the claim, Fitzgerald clearly teaches this broad limitation. That is, Fitzgerald teaches evaluating the interoperability of communications systems by evaluating the quality of service characteristics of various different network subsystems (e.g., see col. 2, lines 19-62). Thus, applicant's argument that Fitzgerald fails to teach such a limitation is not persuasive.

Fifth, applicant argues that applicant's specification includes specific limitations which indicate applicant's claimed "acyclic paths" are different from Fitzgerald's "network topology". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., limitations on page 14 of applicant's specification with respect to an acyclic path) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, applicant's argument is moot.